REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-14, 16-19, 22-24, and 26-31 are now pending, claims 1, 16, 22, 23, and 26 being independent. In this Reply, Applicants have amended claims 1-13, 16-19, 22-24, and 26-30 and have canceled claims 15, 20, 21, and 25 without prejudice or disclaimer. Claim 31 has been added. Furthermore, Applicants have submitted an amended version of Figs. 10a-b, correcting obvious typographical errors in the reference numerals therein. The specification has been amended to properly cross-reference the priority applications.

A Disclosed Embodiment

A disclosed embodiment is directed to a method of generating a product (301, 110) having at least a writing surface and an activation area. Such a product (301, 110) may embodied as a physical product (110), e.g., a paper note page for use with a pen device (710) to record and process information written on a writing surface (303) of the product. The writing surface (303) is provided with a position-coding pattern (e.g., the position-coding pattern illustrated in Figs. 3-4), which codes a plurality of positions on the writing surface. The pen device (710) reads position codes from the writing surface (303) to record information being written thereon. An activation area (308) also includes a position code, which the pen device (710) reads to initiate a predetermined

AMENDMENTS TO THE DRAWINGS

Attached hereto is(are) one (1) sheet(s) of corrected drawings that comply with the provisions of 37 C.F.R. § 1.84. The corrected drawings incorporate the following drawing changes:

FIGs. 10a-b - reference numerals have been amended to correspond to the specification.

It is respectfully requested that the corrected drawings be approved and made a part of the record of the above-identified application.

operation utilizing the information recorded from in the writing surface (303), e.g., communicating such information to a remote server to perform the operation associated with the product.

The product (110, 301) and the pen device (710) enable the user to work in much the same way as he or she does when using paper and pen to initiate and perform electronic information operations. The activation area (308) can be likened to an icon on a computer screen, but instead of placing the screen cursor on the icon and clicking with the aid of a mouse, the user enters a command by positioning the pen device (710) to detect the activation area (308) on the product (110, 301). The information written by the user on the writing surface (303) can include the types of information written by hand, such as text, numbers, figures, and drawings. The product (110, 301) further includes a visual indication (309), which may indicate the type of operation associated with the activation area (308). The product (110, 301) further includes a character interpretation area (A) as another type of writing area.

The position codes used to indicate positions for the writing surface (303) and the activation area (308) are a sub-set of codes from an "imaginary surface," which includes all available position codes. Given the large number of position codes available in the imaginary surface, sub-sets of codes can be allocated to different service providers and/or services, such that the "imaginary

18

surface" functions as a reference surface that can indicate the service provider and/or service associated with a particular position code read by the pen device (710).

An embodiment disclosed in this application provides a method for developing, generating, and testing such a product using a digital template (201), which a user accesses to create a product layout and associate service operations. In the example of Fig. 2, the template (201) is used to develop a note page product/application and comprises a digital representation of a writing surface (203) and a digital representation of available activation fields (207a-g). Upon generating a product layout using the digital template (201), a digital product representation is generated, containing information about the position codes on the product using "image points," which correlate to positions coded by the product's position-coding pattern. The digital product representation also contains information about any areas that are (to be) assigned to dedicated operations. Furthermore, the digital product representation, or a version thereof (print file), may be used in printing the final product. This digital product representation may be used to test/validate functionality of the final product against an application program (which implements the receiving application), without the need to produce a tangible/physical version of the product. In other words, a digital representation shown on a computer display may be used to

19

test/validate the product/corresponding service, without the need to generate the physical product itself.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-30 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, pg. 2 of the Office Action asserts that various claim terms, such as "product," "physical products," "device," "position code," and "image points" are not understood. Applicants respectfully submit, however, that such claim terms are clear and definite, particularly in light of the specification. See e.g., MPEP § 2173.02. As explained above, the present disclosure describes a method for designing, generating, and testing/ validating a product (e.g., a notepad page), wherein the product may be embodied in a "physical product" (e.g., printed note pad page 110) for use with a pen-like writing/reading device (710). The product (110, 301) includes a writing area and an activation area (308), which are provided with different position codes (see Fig. 3-4). A digital representation of a product layout is generated and displayed, such that "image points" in the displayed digital representation correspond to positions in the product layout.

Particularly in view of this disclosed embodiment, the cited claim terms are clear and definite.

Regarding the terms "imaginary surface," "activation area," "template," and "writing surface," Applicants direct the Examiner's attention to Fig. 3 and the corresponding description on pages 17-18 of the disclosure, in which a product layout (301) includes a writing surface (303) and an activation area (308), such a product layout being developed using a digital template (201) illustrated in Fig. 2. The position codes associated with the writing surface (203, 303) and the activation area (207a-g, 308) are codes from a an "imaginary surface," which includes all available position codes. To clarify this aspect of the present invention, Applicants have amended the claims to recite a "reference surface" instead of "imaginary surface." In a disclosed embodiment, a digital representation of the product layout is displayed, such that "image points" on the display correlate to "position codes" in the product.

If this grounds of rejection is maintained, Applicants respectfully request that the Examiner provide some explanation of why, in light of the specification, one of ordinary skill in the art would not be able to determine the scope of such the claim terms cited as being indefinite on page 2 of the Office Action.

Regarding the Examiner's statement on page 2 of the Office Action that the claims are "narrative in form and replete with

indefinite and functional or operational language," Applicants initially note that most pending claims are method claims, which naturally will include functional and operational language. In any event, Applicants have amended the claims in an effort to address the Examiner's assertion that the claims are narrative.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 112, second paragraph.

Prior Art Rejections

Claims 1-30 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated by *Dymetman et al.* (WO 99/50787, hereinafter "*Dymetman*"). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Independent claim 1 is directed to a method for developing a product that has at least one activation area and a writing area, which are each provided with a position code that codes a position on a reference surface, a position associated with the activation area causing a device that detects the corresponding position code to initiate an operation that utilizes a position associated with the writing area. The method of claim 1 comprises: accessing a product development template, the product development template including a writing area and a plurality of available activation areas, the writing area and the activation areas being associated with different positions on the reference surface; designing a

product layout using the product development template, the product layout including position-coded areas and supporting graphics, the position-coded areas including at least a portion of the writing area and at least a portion of an activation area; and producing a digital representation of at least part of the product layout, the digital representation including a plurality of image points, wherein image points in the digital representation are associated with different position-coded areas of the product layout and correspond to positions on the reference surface.

Dymetman discloses an information management system, in which an electronic pointer is operated on a coded page to produce an action over a network. The page is encoded with a page identifier and locations on the page. As the pointer is moved over the page, the pointer records images, which it decodes into page identifier and location pairs. The location information is transmitted to a "digital page." See e.g., page 6, lines 5-11. Upon receipt of the location information, the digital page decodes the location information into an action. Thus, the digital page, which associates actions with locations and code on the substrate, is used to interpret data from the pointer. Although *Dymetman* utilizes this "digital page" to interpret data from the pointer, this operation does not relate to a product development process using a product development template as recited in claim 1.

According to MPEP § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the … claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

At least in view of the above, Applicants respectfully submit that *Dymetman* fails to anticipate claim 1, or any claim depending therefrom. Furthermore, Applicants respectfully submit that independent claims 16, 22, 23, and 26, as well as their dependent claims, define over *Dymetman* based on similar reasoning.

In view of the above, Applicants request reconsideration and withdrawal of the Examiner's prior art rejection.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the

24

amount of $120.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By D. Richard Anderson, #40,439

DRA/jdm
3782-0153P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Replacement sheet for Figs. 10a-b